

REMARKS

The present application was filed on January 5, 2001 with claims 1-42. In the final Office Action, the Examiner: (i) reiterates the rejection of claims 1-5, 7-15, 17-26, 28-36 and 38-42 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,838,819 to Ruedisueli et al (hereinafter “Ruedisueli”); (ii) reiterates the rejection of claims 6 and 27 under 35 U.S.C. §103(a) as being unpatentable over Ruedisueli in view of U.S. Patent No. 5,921,582 to Gusack (hereinafter “Gusack”); and (iii) rejected claims 16 and 37 under 35 U.S.C. §103(a) as being unpatentable over Ruedisueli in view of U.S. Patent No. 6,504,956 to Gannage et al. (hereinafter “Gannage”).

In this response, Applicants: (i) traverse the various §102 and §103 rejections for at least the reasons given below; and (ii) file a Notice of Appeal concurrently herewith.

Applicants incorporate by reference herein the remarks of their previous responses April 4, 2003 and January 23, 2004.

Regarding the §102(b) rejection of claims 1-5, 7-15, 17-26, 28-36 and 38-42, it is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants believe that said claims are patentable over Ruedisueli since Ruedisueli fails to teach or suggest each and every element of said claims and, thus, the rejection fails to meet the above-cited legal requirement.

By way of example, claim 1 recites a method of entering formatted electronic ink data provided in association with a user on a handwriting system which comprises, *inter alia*, the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format . . . wherein a field comprises a delimited area of the writing medium, and the step of providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields. Claims 18, 22 and 39 provide similar limitations.

Ruedisueli discloses something significantly different. As first pointed out in Applicants' previous response dated April 4, 2003 and again in a response dated January 23, 2004, while Ruedisueli relates to a technique for processing and managing electronic copies of handwritten notes in accordance with a handwriting system, Ruedisueli addresses the issue of maintaining synchrony between ink notes on a physical page and the virtual, electronic version of that page. That is, Ruedisueli discloses a technique for assigning writing "sessions" to specific pages, tracking of correct correspondences between the paper copies of notes and the electronic copies (see column 1, lines 38-52), and managing pages electronically stored (see column 1, lines 55-61). See also column 2, lines 10-19, where Ruedisueli states that "each session corresponds with a time period during which a collection of notes are made without being interrupted for the purpose of making a second collection of notes."

On the other hand, the claimed invention recites that the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format wherein a field comprises a delimited area of the writing medium, and the step of providing one or more user-specified indications (e.g., one or more tags or some form of signaling) to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

Advantageously, the claimed invention thus provides annotation of handwritten data for a variety of purposes, in which multiple user-specified indications (e.g., one or more tags or some form of signaling) can be made within a given session and/or page, or can be inserted at a later time. Such user-specified indications may be used to label data to a specific purpose, can have a variety of purposes, are not limited to handwritten entries, can be added at any time and are not restricted to be associated with a session associated to a specific page, can be entered in one session, and can be attached to the same set (or intersecting sets) of strokes.

As is evident, there is a significant difference between the claimed invention and Ruedisueli since Ruedisueli relates to a technique for overcoming the problem of associating virtual ink to the

correct/corresponding page. On the other hand, the claimed invention employs fields (comprising delimited areas of the writing medium) and user-specified indications so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields. This is neither the problem that Ruedisueli addresses nor the solution that Ruedisueli offers to solve its problem.

The final Office Action points to figures 2 and 3 of Ruedisueli where a user is shown entering an item 36 (i.e., page number 1) and an item 28 (i.e., a graph), respectively. The final Office Action goes on to suggest that these items are being entered into a "delimited area" on the writing medium. However, as is clear from figures 2 and 3, the areas that the user is entering the page number and the graph are not delimited in any way on the writing medium. Thus, Ruedisueli does not teach or suggest that "one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format . . . wherein a field comprises a delimited area of the writing medium," as in the claimed invention.

The final Office Action also cites column 4, lines 5-16, of Ruedisueli and suggests that this teaches the claim limitation of permitting "a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields." However, column 4, line 5-16, merely state that a page number (item 36) may be used to manage the electronically captured pages in a natural manner. This is clearly a different concept than providing "a transition between the entry of electronic ink data in accordance with the one or more fields [in a delimited area of the writing medium] and entry of electronic ink data that is not associated with the one or more fields [in a delimited area of the writing medium]," as in the claimed invention.

Lastly, the final Office Action again cites figures 2 and 3 (and the page number referred to as item 36) of Ruedisueli in rejecting the claim limitation "providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields." However, it is not clear how this could teach or suggest the claim limitation. The final Office Action states that "the user can see the ink as he writes on the paper associated with the page number." However, if the Examiner's

argument is that the area that the user writes the page number on the paper is a “field,” then how would the page number itself serve as a “user-specified indication . . . to indicate that electronic ink data entered in association with [the] user-specified indication is to be associated with the one or more fields.” This is not logical. The main reason is because Ruedisueli, as explained above, is not directed toward the same problems that the claimed invention addresses and therefore Ruedisueli does not teach or suggest the features recited in the claims.

To state it another way, the Examiner seems to be suggesting (at page 3 of the final Office Action) that the entry of a page number in the upper right hand corner of a page in Ruedisueli is a “user-specified indication . . . [that] indicate[s] that electronic ink data entered in association with [the] user-specified indication is to be associated with the one or more fields . . . so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields,” as in the claimed invention. Again, this is completely inaccurate. Assuming, *arguendo*, that the upper right hand corner of a page in Ruedisueli could be considered a field and the entry of a page number could be considered a user-specified indication and the rest of the page could be considered an area not associated with the field (all assumptions that Applicants reject as indicated above), the entry of a page number into the upper right hand corner of the page would in no way permit or facilitate a transition between the entry of electronic ink data in the upper right hand corner of the page and entry of electronic ink data on the rest of the page. In accordance with the problems that Ruedisueli addresses (i.e., maintaining synchrony between ink notes on a physical page and the virtual, electronic version of that page), the page number may be used to permit or facilitate transition between pages, not between the upper right hand corner of a page and the rest of the page. Again, this is because Ruedisueli clearly does not address the same problem or solution that the claimed invention addresses, and therefore Ruedisueli does not teach or suggest the above-cited claim language.

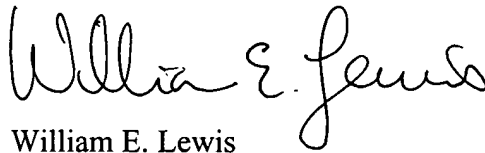
Furthermore, Applicants assert that the claims which depend from independent claims 1, 18, 22 and 39 are not only patentable over the cited reference in view of the above reasons, but also because such dependent claims recite patentable subject matter in their own right.

Further, since Gusack and Gannage fail to remedy the deficiencies of Ruedisueli, Applicants assert that claims 6, 16, 27 and 37 are patentable over the cited combination.

Accordingly, withdrawal of the §102(b) and §103(a) rejections of the claims is respectfully requested.

In view of the above, Applicants believe that claims 1-42 are in condition for allowance, and respectfully request favorable reconsideration.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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